Box Non-Fee Amendment
Attorney Docket No. 24734

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

CHERUKURI et al.

Serial No.: 10/024,583 Group Art Unit: 1654

Filed: December 21, 2001 Examiner: S. Coe

For: **SUGAR-FEE CHEWY PRODUCTS AND PROTEIN-BASED CHEWY PRODUCTS AND METHODS FOR MAKING THE SAME**

TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Submitted herewith for filing in the U.S. Patent and Trademark Office in connection with the above-identified patent application are the following documents:

(1) Transmittal letter; and
(2) Response to Restriction/Election Requirement.

Please charge any required fee, or credit any overpayment, in connection with this matter to deposit Account No. 14-0112.

Respectfully submitted,

Date: January 29, 2003 By: _____

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RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Commissioner of Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action dated December 30, 2002. The one-month shortened statutory period for response is set to expire on January 30, 2003; accordingly this response should be considered timely filed.

SUMMARY OF RESTRICTION REQUIREMENT

Invention Groups. The Examiner has required restriction of claims 1-39 to a single disclosed species under 35 U.S.C. 121 and 372. As the basis for this restriction requirement, the Official Action states the following:

2. Restriction is required under 35 U.S.C. 121:
   I. Claims 1-35, 38 and 39, drawn to a sugar-free composition, classified in class 424, subclass 725.
   II. Claims 36and 37, drawn to a method of making a composition, classified in class 424, subclass 725.

3. Inventions II and I are related as process of making and product made. The inventions are distinct if eithere or both of the following can be shown: (1) that the process as claimed can bee used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made in a different manner subh as mixing the ingredients together at room temperature.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

A) polyols selected from those in claims 2 and 17;

B) fats selected from those in claims 3 and 20;

C) emulsifiers selected from those in claim 6 and 21;

D) active agents selected from those in claims 7, 22 and 39;

E) viscosity improvment agents selected from those in claims 9 and 42;

F) bioadhesive agents selected from those in claims 11 and 26; and

G) fibers selected from those listed in claims 15 and 35 (if fiber is elected as the active agent).

If group I as set forth above is elected, applicant is required under 35 U.S.C. 121 ti elect a single disclosed species for each A, B, C, D, E, F, and G for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-13, 16-33 and 36-39 are generic.

An example of a proper election is: Group I; species A" glycerine and sorbitol; species B: palm oil; species C: lecithin; species D: dietary fiber; species E: guar gum: species F: ethyl cellulose: and G: pectin.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected that is consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatenable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.148(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

PROVISIONAL ELECTION

Applicant provisionally elects the inventive subject matter of Group I, with traverse, for prosecution at this time. Applicant respectively submits that Group I contains claim 1-35, 38 and 39. In addition, Applicant provisionally elects the following species, with traverse, for prosecution at this time: species A: hydrogen starch hydrolysate and lactitol; species B: partially hydrogenated soybean oil; species C: lecithin; species D: dietary fibers;

species E: carrageenan; species F: hydroxypropylmethyl cellulose; and species G: psyllium. Applicant respectfully submits that claims 1-35, 38 and 36 read on the elected invetion.

TRAVERSAL

Applicant respectfully traverse the Examiner's restriction requirement.

As an initial matter, Applicant respectfully submits that the Examiner's assertion that the product may be produced by another, alternative process is inaccurate. The Examiner states that the product may be made by mixing the ingredients at room temperature. However, Applicant respectfully submits that the elevated temperature is needed in order to properly form the emulsion between the polyols and the fat system. Mixing the ingredients will not properly form the emulsion, thus resulting in a product in which the fats separate out from the remaining components. Thus, mixing the ingredients at room temperature will **not** result in the claimed product.

Furthermore, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "**serious burden**" if a restriction were not required. See MPEP 803.

Regardless of any differences which may exist between the inventions set forth in the different groups, a complete and thorough search for the invention set forth in any one of the groups **would require searching the art areas appropriate to the other groups, especially given the identical classifications.** Since a search of each of the inventions of the groups would be coextensive, it would not be a **serious** burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims, **especially considering the identical classifications for the two groups.** Considering that the Examiner must search the generic claims, searching for the other claims would be minimally burdensome on the Examiner. Surely a search of one group will require searching the classes and subclasses of the other groups.

Accordingly, given the overlapping subject matter and classifications of the groups, examinations of all the groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at

the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, Applicant has paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring Applicant to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing Applicant to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

CONCLUSION

In view of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

Attorney Docket: 24734
Serial No.: 10/024,583
Filed: December 21, 2001

Respectfully submitted,

NATH & ASSOCIATES

Date: January 29, 2003

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